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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,436	01/30/2002	Steve G. Baker	ENDOV-59271	5619
24201	7590	06/03/2004	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP			BARRETT, THOMAS C	
HOWARD HUGHES CENTER			ART UNIT	PAPER NUMBER
6060 CENTER DRIVE			3738	
TENTH FLOOR				
LOS ANGELES, CA 90045				

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/066,436	BAKER ET AL.
	Examiner Thomas C. Barrett	Art Unit 3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on February 17 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 22-32 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 22-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

In view of the appeal brief filed on February 17, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The Applicant argues, "It is respectfully submitted that combining the Rhodes and Lazarus et al. references under 103 is improper because there is no suggestion or motivation, nor an objective reason for the combination. It is particularly improper here since Rhodes is concerned with avoiding the shortcomings of self-expanding structures and specifically teaches a stent formed from rigid links or struts (Col. 6, ln. 33). Therefore, in violation of MPEP 2143.01, modifying Rhodes in view of Lazarus "would change the principal operation of the prior art invention being modified." That is, the combination of teachings employed in the final Office action requires Rhodes to be modified to incorporate a self-expanding frame which is, in fact, the very characteristic Rhodes seeks to avoid."

Contrary to the Applicant's argument, motivation is found within Lazarus as noted in the rejection below. Furthermore, the combination would not change the *principal operation* of the prior art invention being modified. The Rhodes reference would not require a substantial reconstruction and redesign of elements shown in the as well as a change in the basic principle under which the construction was designed to operate. For example, a self-expanding stent can still be expanded with a balloon and the device would still function as an endovascular bypass graft. Rhodes states that the method of use of the graft entails introducing it by utilizing "some means, e.g., disposing the sleeve on a conventional balloon catheter." This implies that other means are possible even though a balloon catheter is preferred.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes (5,122,154) in view of Lazarus et al. (5,275,622). Rhodes discloses a graft comprising: a plurality of discrete non-overlapping self-expanding frames (30) along its length, which may be inside the graft (col. 4, lines 19-22), and have wall engaging members (col. 7, lines 18-30), and wherein the graft is pleated, which may provide a tapered profile (Fig. 6) however Rhodes fails to disclose the frames as self-expanding.

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Lazarus et al. teaches self-expanding frames (Fig.11) to yieldably urge the graft from a compressed position to a second expanded condition (col. 8, lines 44-49). It would have been obvious to one of ordinary skill in the art to combine the teaching of self-expanding frames, as taught by Lazarus et al., to a graft as per Rhodes, in order to yieldably urge the graft from a compressed position to a second expanded condition. Rhodes also fails to disclose a frame having a plurality of helical apices that extend beyond the length the graft, that have hooks as wall engaging members. Lazarus et al. teaches a graft comprising a frame having a plurality of helical apices that extend beyond the length the graft, that have hooks as wall engaging members (Fig.11) to serve as attachment means at each end of the graft and when implanted oppose migration of the graft (col. 9, lines 60-62). It would have been obvious to one of ordinary skill in the art to combine the teaching of a graft comprising a frame having a plurality of helical apices that extend beyond the length the graft, that have hooks as wall engaging members, as taught by Lazarus et al., to a graft as per Rhodes, in order to serve as attachment means at each end of the graft and when implanted oppose migration of the graft.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Barrett